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**REMARKS**

Claims 1-19, 29 and 31 are pending in the Application. Claims 20-28 and 30 had previously been withdrawn as non-elected subject matter. Applicants preserve the right to pursue the withdrawn subject matter by way of divisional application(s) if Applicants choose to do so.

The allowance of Claims 18-19 is sincerely appreciated. Withdrawal of the various 112, 102(a) and 102(b0) rejections is also sincerely appreciated.

Claims 5 and 7-9 are objected to.

Claims 1-4, 6, 10-17, 29 and 31 continue to be rejected under 35 U.S.C. § 103 (a) as being unpatentable over Oku, U.S. 5,574,042. The Examiner points out that the reference compound has a methyl in the 2-position, whereas the present compounds do not. However, the Examiner states: "At the time of the invention, one of ordinary skill in the art would have been motivated to replace the methyl with the alternative hydrogen to arrive at the instant invention with the reasonable expectation of obtaining an additional bradykinin antagonist compound ...". Applicants respectfully disagree with the Examiner's contention. However, in the interest of advancing the prosecution to allowance of the claims and not as an admission that the cancelled scope is not patentable, Applicants are canceling certain scope from the definition of R<sup>3</sup> in claim 1 and any dependent claims. The cancelled scope is the description for the substituent shown as R<sup>3</sup> in Oku. Applicants continue to believe that replacing a methyl with H is not necessarily an "obvious" variation and are preserving the right to pursue the cancelled subject matter by way of divisional application(s) if Applicants choose to do so. Withdrawal of the 103(a) rejection is, therefore, respectfully requested.

Claims 1-4, 10-17, 29 and 31 are rejected under 35 U.S.C. § 112, first paragraph. In its last response, Applicants had added a proviso to remove certain compounds from the generic scope of claim 1 that the Examiner had cited in the previous Office Action as found in the art. It is now stated that the proviso Applicants added to claim 1 to remove the compounds the Examiner had earlier cited in the art "is not found in the specification". Applicants respectfully traverse the rejection.

It is well established in the case law that the use of a proviso is not new matter, but merely an amendment to the claim to excise subject matter to which the inventor is not entitled. See, for example, *In re Johnson et al.*, 558 F.2d 1008 (CCPA 1977); 194 U.S.P.Q. (BNA) 184. The court in *Johnson* cites to *In re Wertheim*, 541 F.2d 257; 191 U.S.P.Q. 90 (CCPA, 1976) and states "Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. It is for the inventor to decide what *bounds* of protection he will seek". *In re Johnson et al.* at 1018. The court went on to say:

5 "Appellants... are narrowing their claims, and the full scope of the limited genus now claimed is supported in appellants' earlier application, generically and by specific examples. ...The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species there within, has somehow failed to disclose, and teach those skilled in the art how to

10 make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. .... Here, ... **the "written description" ... supported the claims in the absence of the limitation, and that specification, having described the**

15 **whole, necessarily described the part remaining.** The facts of the prosecution are properly presented and relied on, under these circumstances to indicate that **appellants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter."** *Johnson*, 1019 (emphasis added). The *Johnson* decision is referred to

20 in *In re Driscoll*, 562 F.2d 1245, 1250 (CCPA 1977) as "yet another instance of the "hypertechnical application" of the written description requirement of §112...". In the present case, Applicants believe that the proviso added to exclude ("excise") certain compounds of the art from the generic description, which by the way is well supported by the numerous examples in the present case, is not new matter,

25 as supported by *In re Johnson*. Withdrawal of the §112, first paragraph, rejection is, therefore, respectfully requested.

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There being no other rejections pending, Applicants believe that the claims, as amended, are in allowable condition and such an action is earnestly solicited. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

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Respectfully submitted,



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